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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HARBECK, TIMOTHY M

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,132

Applicant(s)

SZE, VICKY

Examiner

Timothy M. Harbeck

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin et al (hereinafter Conklin, US Pat No 6,141,653) in view of Horn et al (hereinafter Horn; Pub No. US 2001/0037204 A1).

Re Claim 1: Conklin discloses a method for interactive multivariate negotiations over a network including:

- Recording establishment of a commerce transaction agreement between a first and second parties for purchase of an offering, wherein the commerce transaction agreement is established utilizing a network based transaction system and wherein the commerce transaction agreement imposed first and second obligations on the first and second parties (see abstract)

Conklin does not explicitly disclose the step of

- Automatically presenting a reminder option to the first party that is exercisable by the first party to remind the second party to comply with the obligations of the second party imposed under the commerce transaction agreement

Horn discloses a system and method for online resolution of disputes wherein "the system is designed to minimize overhead costs by automatically reminding the parties of a pending settlement offer" (Page 2, Paragraph 0017)

It would have been obvious to someone skilled in the ordinary art at the time of invention to include the reminder feature taught by Horn to the system of Conklin to eliminate the need for constant follow up correspondence and telephone calls by one party to the transaction should the other default on the agreement.

Re Claim 2: Conklin in view of Horn discloses the claimed method supra and Horn further discloses automatically presenting the reminder option a predetermined time interval after the establishment of the commerce transaction agreement between the first and second parties (Page 8, Paragraph 0099)

Re Claim 3: Conklin in view of Horn discloses the claimed method supra and Horn further discloses the step wherein the predetermined time interval is at least three days (Page 3, Paragraph 0027)

Re Claim 4: Conklin in view of Horn discloses the claimed method supra and Horn further discloses automatically disabling the reminder option after the issuance of a predetermined number of reminders to the second party by exercising the reminder option by the first party (Page 3, Paragraph 0027)

Re Claim 5: Conklin in view of Horn discloses the claimed method supra and Horn further discloses wherein the reminding of the second party comprises issuing an electronic communication to the second party (Page 3, Paragraph 0027).

Re Claim 6: Conklin in view of Horn discloses the claimed method supra and Horn further discloses the step wherein the electronic communication includes any one of a group of communications including an electronic mail message, a page message, a wireless access protocol (WAP) message, a simple message service (SMS) message and a display on a markup language document (Page 3, Paragraph 0027).

Re Claims 7 and 8: Conklin in view of Horn discloses the claimed method supra and Horn further discloses wherein the first party comprises either a buyer or a seller and the second party is the reciprocal. Horn notes the system can be used for commercial transactions (Page 2, Paragraph 0019), and further describes the communication process as being between the two parties regardless of their role in the transaction (Page 2, Paragraphs 0020-0023).

Re Claim 9: Conklin in view of Horn discloses the claimed method supra and Conklin further discloses the step wherein the commerce transaction is concluded between the first and second party utilizing a network-based auction facility, and wherein the recording of the establishment of the commerce transaction agreement is preformed at the network-based auction facility (Column 14, lines 27-54).

Re Claim 10: Conklin in view of Horn discloses the claimed method supra and Conklin further discloses the step wherein the commerce transaction agreement is concluded between first and second parties utilizing a peer-to-peer trading system, and wherein the recording of the establishment of the commerce transaction agreement is performed at a computer systems of the first party (Column 14, lines 38-54). Conklin

establishes an inventive step over this claimed step, thus establishing this method as known prior to the time of invention.

Re Claim 11: Conklin in view of Horn discloses the claimed method supra and Horn further discloses the step wherein the automatic presentation of the reminder option comprises presenting a reminder display element utilizing a graphical user interface, the reminder display element being user-selectable to initiate a reminder process (See Figures 35,36,40).

Re Claim 12: Conklin in view of Horn discloses the claimed method supra and Horn further discloses the step wherein the reminder display element comprises any one of a group of elements including a graphic element and a text element (See Figures 35,36,40).

Re Claim 13: Conklin in view of Horn discloses the claimed method supra and Horn further discloses the step wherein the graphical user interface comprises a markup language document (Page 11, Paragraph 0145).

Re Claim 14: Conklin in view of Horn discloses the claimed method supra and Horn further discloses the step wherein the reminder display element is displayed in association with description information regarding the commerce transaction (See Figure 36).

Re Claim 15: Conklin in view of Horn discloses the claimed method supra and Horn further discloses the step wherein the reminder display element is displayed first in a first state prior to the expiration of a predetermined time interval after the establishment of the commerce transaction agreement to indicate that the reminder

option is unavailable until after expiration of the predetermined time interval (See Figure 36 and Page 8, Paragraph 0099).

Re Claim 16: Conklin in view of Horn discloses the claimed method supra and Horn further discloses the step wherein the reminder display element is displayed in a second state subsequent to exercising of the reminder option a predetermined number of times by the first party (See Figures 38 and 42 and Page 8, Paragraph 0099)

Re Claim 17: Conklin in view of Horn discloses the claimed method supra and Horn further discloses the step wherein the reminder display element is displayed in a third state to indicate that the reminder option is available to the first party after the expiration of the predetermined time interval and prior to the exercising of the reminder option a predetermined number of times by the first party (See Figure 39, Page 8 Paragraph 0099). Horn discloses, as an example, a system that allows the first party to reissue a reminder if the second party does not respond within 30 days, however there is an absolute deadline of one year. Therefore there would be a predetermined number of times the first party can issue a reminder before the claim is aborted. Figure 39 shows a portfolio of claims for a user, with each individual claim having a status (state) associated with the process.

Re Claims 18-34: Further system claims 18-34 would have been obvious to perform method claims 1-17 respectively, and are therefore reject using the same art and rationale.

Re Claim 35: Further computer readable medium claim 35 would have been obvious from previous method and system claims 1 and 18 respectively and are therefore rejected using the same art and rationale.

Response to Arguments

Applicant's arguments filed 12/05/2005 have been fully considered but they are not persuasive. Applicant has argued that that neither the Conklin or Horn reference teaches the limitation of "presenting a reminder option to the first party that is exercisable by the first party to remind the second party to comply with the obligations of the second party to remind the second party to comply with the obligations of the second party imposed under the commerce transaction agreement. Examiner agrees with the applicant that the Conklin reference does not explicitly disclose this limitation. However the examiner does believe that Horn teaches this limitation, which is why this particular reference was brought into the previous rejection. Horn discloses the step of "automatically reminding the parties of a pending settlement (paragraph 0017)" and further notes that the communication can occur directly between the parties (0017). Furthermore, after receiving the reminder, either party has the exercisable option of initiating communication with the other party regarding the transaction and the obligations thereof (paragraph 0020). The applicant has stated his belief that Horn is a dispute resolution system and not a reminder option, but the fact that one party is reminding the other party to comply with obligations in the current invention is a form of dispute resolution (most likely non payment), and therefore the system and method of Horn fulfills this limitation.

With respect to the applicants argument that neither Conklin nor Horn implicitly or explicitly discusses a compliance obligation imposed under a commerce transaction agreement by a second party, as recited in claim 1, the examiner is unsure of the limitation the applicant is referring to, as "compliance obligation" is not disclosed in the claimed language. However, the examiner would like to point out that any transaction, such as the ones disclosed in both the Horn and Conklin reference, impose some type of obligation in which the parties must comply.

For theses reasons and the ones stated in the Office Action, the rejections based upon the cited prior art are maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
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